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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,209	09/26/2003	Yasuyuki Sugi	114468.01	4484

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EXAMINER

DINH, JACK

ART UNIT PAPER NUMBER

2873

DATE MAILED: 04/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/670,209	Applicant(s) SUGI ET AL.	
	Examiner Jack Dinh	Art Unit 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 11-16 is/are allowed.
6) ☒ Claim(s) 1,3 and 7-10 is/are rejected.
7) ☒ Claim(s) 2,4,5,6 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 26 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>0903</u> . | 6) <input checked="" type="checkbox"/> Other: <u>DETAILED ACTION</u> . |

DETAILED ACTION***Drawings***

1. Figure 12 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections – Nonstatutory Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

3. Claims 1 and 3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12 and 17 of U.S. Patent No. 6,678,096 (e.g. '096). Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 1 and 3 are directed to a lens for multiple wavelength condensing two or plural kinds of monochromatic lights respectively by

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refraction, which are based entirely upon the features/limitations of claims 12 and 17 of '096. In particular, independent claims 1 and 3 of the instant application recites a lens having the same/equivalent basic features/limitations taken from the aforesaid '096, except that the ratio of the differences of each of the monochromatic lights in each of the aspherical zones is between 0.4 and 2.5. However, the applicant does not provide any evidence that such omission would cause the lens of claims 1 and 3 to provide any unexpected results different from those of claims 12 and 17 of '096. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to omit such limitation since the remaining elements would cause the lens to perform the same functions as before.

4. Claims 7-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12 and 17 of U.S. Patent No. 6,678,096 (e.g. '096). Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 7-10 are directed to an optical head and optical disc apparatus using a lens according to claims 1 and 3 of the instant application, which has the same equivalent claim structures as claims 12 and 17 of '096, as described above. Since the invention relates to an objective lens installed in a recording and reproducing apparatus, it would have been obvious that the lens would be installed in an optical head or an optical disc apparatus. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose an optical head or an optical disc apparatus as recording or reproducing apparatus in which the lens is installed.

5. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Allowable Subject Matter

6. Claims 2 and 4-6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 11-16 are allowed. The following is a statement of reasons for the indication of allowable subject matter. The following is a statement of the examiner's reasons for allowance. The present invention relates to a design method for an objective lens installed in a recording and reproducing apparatus of a multiple wavelengths optical system using plural kinds of monochromatic lights which is compatible with optical storage medium of different types. Regarding claims 2 and 4, the prior art fails to further disclose that the wavelength comprises at least two kinds of wavelength selected from a group of around 790nm, 655nm and 405nm. Regarding claims 5 and 6, the prior art fails to further disclose that the lens condenses each wavelength of light onto an information surface with a Root Mean Square (RMS) wavefront aberration of no more than 0.035λ . Regarding claims 11, 13, 15 and 16, the prior art fails to disclose that one wavefront aberration for a wavelength with a smaller

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numerical aperture of the lens is smaller than other wavefront aberration for a wavelength with a larger numerical aperture of the lens in each of the aspherical zones in the common use area. The claimed invention is therefore considered to be in condition for allowance as being novel and non-obvious over prior art.

7. The prior art taken either singly or in combination fails to anticipate or fairly suggest the limitations of the independent claims, in such a manner that a rejection under 35 USC 102 or 103 would be improper. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Other Information/Remarks

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Dinh whose telephone number is 571-272-2327. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y Epps can be reached on 571-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jack Dinh



Georgia Epps
Supervisory Patent Examiner
Technology Center 2800